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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,189	08/21/2003	John D. McNicol	801,461-009	9078
34263	7590	01/05/2006		
O'MELVENY & MYERS LLP 610 NEWPORT CENTER DRIVE 17TH FLOOR NEWPORT BEACH, CA 92660			EXAMINER LASTRA, DANIEL	
			ART UNIT 3622	PAPER NUMBER
DATE MAILED: 01/05/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/646,189

Applicant(s)

MCNICOL ET AL.

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claim 18 has been examined. Application 10/646,189 has a filing date 08/21/2003 is a continuation of 09/481,778 (Pat 6,615,179; 01/11/00) which is a continuation in part of 09/241,937 (Pat 6,347,301; 02/02/99).

#### ***Response to Restriction Requirement***

2. In response to Restriction requirement filed 05/31/2005, the Applicant filed a Response to Election / Restriction on 10/31/2005, which elected group III (claim 18).

#### ***Double Patenting***

Claim 18 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of McNicol (U.S. Patent No. 6,615,179). Although the conflicting claim is not identical, they are not patentably distinct from each other because the instant claims recite the limitation of providing a "plurality" of data distribution node instead of "at least one" data distribution node having means to download data, as recited in the patent. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the same downloading steps would be performed with "at least one" or a "plurality" of said data distribution nodes.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 3622

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 18 is rejected under 35 U.S.C. 102(e) as being anticipated by Kolls (US 6,609,102).

As per claim 18, Kolls teaches:

A method for providing an electronic concierge service to a hotel guest comprising:

providing a central computer comprising a central microprocessor operably coupled to a central data storage unit (see figure 4);

programming into the central data storage unit an entertainment database (see column 6, lines 45-60);

providing the hotel guest with a hand-held computer comprising a display screen, a keypad, a data storage unit, a data transfer mechanism, and a microprocessor coupled to the display screen, the keypad, the data storage unit, and the data transfer mechanism (see figure 4, column 3, lines 40-60; column 13, lines 10-20);

providing a plurality of data distribution nodes comprising a data transfer unit configured to download data from the central data storage unit to the hand-held computer in response to the data transfer mechanism of the hand-held computer (see column 19, lines 44-60, figure 6b);

installing the data distribution nodes in publicly accessible locations around the hotel (see figure 6b, column 19, lines 44-60);

operably coupling the data distribution nodes to the central computer (see figure 4b);

inputting into the entertainment database entertainment information of interest to the hotel guest (see column 19, lines 44-60);

operatively coupling the hand-held computer with the closest of the plurality of data distribution nodes and transmitting information from the entertainment database from the central computer to the hand-held computer (see column 19, lines 44-60; column 32, line 15 – column 33, line 18).

#### ***Response to Arguments***

4. Applicant's arguments filed 10/31/2005 have been fully considered but they are not persuasive. The Applicant argues that the election is done with traverse because in the Office action mailed November 29, 2004, the Examiner indicated that "claims 1-20 have been examined", yet did not issue a restriction requirement. The Examiner answers that the Examiner did not make a restriction requirement because in said Office Action, the Examiner did a Statutory Double Patenting rejection. However, because said Double Patenting Rejection was withdrawn, the Examiner had to file a Restriction requirement, as the Applicant's claims are not all in the same art.

#### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

Art Unit: 3622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra  
December 15, 2005

*Yehdega Retta*  
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PRIMA EXAMINER